

### **REMARKS/ARGUMENTS**

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this amendment, claims 1, 7, and 12 have been amended. Thus, claims 1-16 are pending for further examination.

#### **Rejection Under 35 USC 112, First Paragraph**

Claims 1-16 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Without acquiescing to the propriety of the rejection, Applicant has amended independent claims 1, 7, and 12. Thus, withdrawal of this rejection is respectfully requested.

#### **Rejection Under 35 USC 103**

Claims 1-16 remain rejected under 35 USC 103 as allegedly being obvious over Ventrella in view of Bickmore. Without acquiescing to the propriety of the arguments in the Office Action, and without acquiescing to the propriety of the rejections under 35 USC 103, Applicant has amended claims 1, 7, and 12 to more patentably distinguish the invention defined by the claims from the prior art of record. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

#### ***The Alleged Combination of References Does Not Disclose Every Limitation of Claim 1.***

For a claim to be properly rejected under 35 USC 103, each and every limitation of that claim must be taught or suggested in a combination of references. Ventrella and Bickmore, alone and in combination, do not disclose all of the limitations of claim 1. For example, Ventrella and Bickmore, alone and in combination, fail to teach or suggest

“using the location of the tag and the tag information to dynamically modify the user-controlled character’s animation and the animation of the object associated with the tag in real time.”

Previous Office Actions have alleged that the stimulus mentioned in Ventrella discloses the tags required by claim 1. Applicant continues to object to this application. According to Ventrella, stimuli only have an affect on an avatar if a gene and/or a Newtonian mechanics module associated with that avatar are applicable and activated. The avatars of Ventrella are non-functional without both genes and the Newtonian mechanics module. The invention defined by the claims, however, is not comparable, because the user-controller character is animated based on user input and information stored in the tag, regardless of any peculiar traits specific to the user-controller character.

However, even assuming that Ventrella’s stimuli applied to the tags of the claimed invention, Ventrella still would not disclose the above-noted limitation. Assuming, *arguendo*, that Ventrella teaches using a tag to animate an avatar, Ventrella does not teach using the same tag to animate the object associated with the tag. For example, according to Ventrella, an avatar might stare at a bird or turn its head to follow the flight of the bird. Assuming that the bird is a tagged object, Ventrella simply does not teach or suggest doing anything to the bird itself.

To the contrary, as the example provided with reference to Figures 6-9 of the present application illustrates, both the user-controlled character and the objects associated with the tags are modified in response to tag information embedded therein.

Bickmore was introduced to teach embedding tag information into a tag. However, Bickmore fails to make up for the deficiency noted with respect to Ventrella. Specifically, Bickmore only discloses having an avatar provide information related to the document when the avatar is dragged over the tagged object (e.g. text, an image, etc.). In no way does Bickmore teach or suggest modifying the tagged object. To the contrary, Bickmore teaches avatar-mediated navigation through a document or series of documents. The notion of changing the text, image, or other tagged object of a document based on information stored in that tag is foreign to Bickmore. Indeed, the Avatar Scripting Language disclosed in Bickmore relates merely to methods of changing the avatar, not any part of the document itself.

As such, even if the combination of Ventrella and Bickmore were appropriate, the alleged combination still would not render obvious the invention defined by the claims.

*The Alleged Combination of Ventrella and Bickmore is Inappropriate.*

For a claim to be properly rejected based on a combination of references, there must be, *inter alia*, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* MPEP 2143. There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

The differences between the two references are so numerous and significant that one of ordinary skill in the art at the time of the invention would not have been motivated to combine the teachings of Bickmore and Ventrella. *See Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Furthermore, the proposed combination of Ventrella and Bickmore would change the principle of operation of the prior art invention being modified. Thus, Applicant respectfully submits that the teachings of the references are not sufficient to render the claims *prima facie* obvious. *Cf. In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

First, Ventrella is directed to a player character in a three-dimensional virtual world, whereas Bickmore is directed to a flat, two-dimensional document. The avatar of Bickmore exists as attached to a flat, two-dimensional document (i.e. docked at the side of an HTML document or over an “avatar link”). There is no mistaking that Bickmore pertains to a two-dimensional avatar. Bickmore explicitly states that “in this discussion, a two-dimensional avatar is described” (§ 40). When the avatar is resized it is scaled over two dimensions (§ 56).

Similarly, there is no mistaking that Bickmore is directed to a document. Indeed, the whole purpose of the invention is to “provide[] a method and system for creating autonomous personal representatives, or avatars, that can be attached to an *electronic document*” (§ 9). As the abstract states:

A method and apparatus for facilitating *communication about a document* between two users creates autonomous, animated computer characters, or avatars, which are then *attached to the document* under discussion. The avatar is created

by one user, who need not be the *author of the document*, and is *attached to the document* to represent a point of view.

The Background notes problems with adding information to documents (§ 7). All of the example embodiments described in the specification pertain to documents and/or HTML documents. Thus, Applicant submits that one of ordinary skill in the art would not look to a method for conveying pre-recorded information in a static, flat document when trying to build an avatar to exist in, and respond to, a dynamic, three-dimensional virtual world. Even if a person having ordinary skill in the art were presented with Ventrella and Bickmore, the combination therebetween would fundamentally alter the underlying principles of operations. Thus, Applicant submits that the alleged combination is insufficient to render the claimed invention obvious. *Cf. In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Similarly, given the fundamentally different purposes the avatars in Ventrella and Bickmore serve, one of ordinary skill in the art at the time of the invention (and even today) would find the teachings of Ventrella and Bickmore inapposite based on the comparative levels of spontaneity and the modes of navigation. Specifically, Ventrella teaches having a player character in a virtual world react dynamically based on pre-defined characteristics (genes). Bickmore, on the other hand, teaches having an avatar react in response to a calculated, purposeful action. As suggested in Bickmore, a purposeful action might include a user moving a mouse over certain pre-defined text. Thus, the teachings and suggestions of Bickmore involve calculated movements by the

user that are not reconcilable with the purported spontaneity of Ventrella, and, especially, with the dynamic virtual world of the claimed invention.

Moreover, Ventrella teaches navigating through a virtual world via an avatar. Bickmore, however, teaches navigating through a document space using a separate input device. Unlike the avatar in Ventrella that visually represents user input, the avatar in Bickmore only responds to certain pre-defined events (such as a user clicking on a certain link). Thus, the objects of the avatars in Ventrella and Bickmore are fundamentally different – the avatar of Ventrella is the manifestation of user input that changes according to pre-defined stimuli, while the avatar of Bickmore is merely a means for conveying certain pre-defined information allegedly stored in tags in response to a pre-defined user action. Differently stated, *the user in Ventrella moves through a virtual environment by using the avatar, whereas the avatar in Bickmore moves the user through a document*. Thus, because the objects of the respective avatars differ so greatly, Applicant again respectfully submits that one of ordinary skill in the art would not combine the teachings of Ventrella and Bickmore without altering the underlying principles of the prior art.

Third, Applicant submits that one of ordinary skill in the art would not combine Ventrella and Bickmore because of the very examples contained in Bickmore. Again, Ventrella is directed to a three-dimensional, *virtual environment*. The examples in Bickmore, however, are directed to *static documents* created with HTML. Words, paragraphs, and the like are tagged in Bickmore, whereas cats, forests, birds, and the like

are tagged in Ventrella. The environments used and objects tagged are significantly different. Applicant submits that one of ordinary skill in the art at the time of the invention would not consider techniques associated with a webpage when building a game.

The Office Action alleges that motivation to combine comes from Ventrella's suggestion "that stimuli can be prioritized using any reasonable criteria." Even if true, the criteria used to prioritize stimuli (which arguably are not even tags in the first place) simply does not pertain to the means used to do the prioritization. Furthermore, a recognition for a need for ordering criteria does not import a concomitant need for specific means of prioritization. Even if convenience were a sufficient motivation, there are no teachings of such needs with respect to tags (or even stimuli) in the prior art of record. The only place convenience and ease of programming appears is in Applicant's specification. But the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least the foregoing reasons, then, Applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have been motivated to combine the teachings of Ventrella and Bickmore. Such a combination would change the underlying principles of the prior art, can only be the result of impermissible hindsight, and likely is suggested only by Applicant's own specification.

### **Conclusion**

For at least the above reasons, Applicant believes that the claimed invention is not obvious in view of the cited prior art. Thus, reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

Applicant also submits that amended independent claims 7 and 12 are not rendered obvious by the cited references for substantially the same reasons set forth above with respect to claim 1. Applicant respectfully submits that the remaining claims (i.e. claims 2-6, 8-11, and 13-16) are allowable at least by virtue of their respective dependence from allowable independent amended claims 1, 7, and 12.

In view of the foregoing remarks, Applicant believes that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, withdrawal of the rejection and passage of this case to issuance at an early date are earnestly solicited.



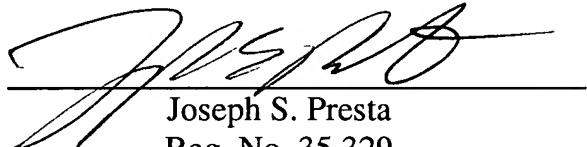
STERCHI et al.  
Appl. No. 10/078,526  
August 29, 2006

Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:

  
\_\_\_\_\_  
Joseph S. Presta  
Reg. No. 35,329

JSP:jr  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100